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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/595,118      | 02/23/2006  | Miroslav Simonek     | JANK.P-001-NP       | 2940             |

57380 7590 04/07/2010  
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| EXAMINER |
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SMITH, CHAIM A

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| ART UNIT | PAPER NUMBER |
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1782

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| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

04/07/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-oppedahl@oppedahl.com



|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/595,118 | <b>Applicant(s)</b><br>SIMONEK, MIROSLAV |  |
|                              | <b>Examiner</b><br>CHAIM SMITH       | <b>Art Unit</b><br>1794                  |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/23/2006</u> . | 6) <input type="checkbox"/> Other: ____.  |



## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a wrapping for used chewing gum, does not reasonably provide enablement for the construction of said wrapping. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification fails to teach how to make or use the invention as claimed. It is not clear what the structural relationship between the elements as disclosed or shown in the figures. It is unknown how both parts are attached along their margins. Are the parts glued or otherwise adhered to one another or only joined by the disclosed but unclaimed tabs? This is also not clear from the drawing or disclosure since the tabs are disclosed as "false" tabs and said tabs do not appear in figures 2 - 4 making it unclear if the tabs are to be present.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randak, Sr. US 2,990,100 as further evidenced by Comino et al. EP 0 642 993 and Badura EP 0 779 040.

4. Regarding claim 1, Randak, Sr. discloses a wrapping capable of being used for used chewing gum (fig. 1) characterized in that the wrapping is formed by an upper part and a lower part of identical form and size, and the upper and lower part are disposed to be applied together by their full surfaces (fig. 1, 3, 6, and 7). The limitations of the claim do not exclude figures 6 and 7 since the upper and lower parts are identical in form and size. Both parts are provided with opposite situated vertical pre-scored lines (fig. 6, ref. # 21) and the parts are attached together along their margins partially in that the top of said wrapping is unattached so as to be openable for the depositing of waste material. With respect to the margins being attached together from one half to one third the circumference of the parts, the particular amount of circumferential attachment is seen to have been an obvious matter of choice. Further regarding the use of the wrapper with used chewing gum, since said wrapper is designed to contain waste material without said material spilling out it would have been obvious that the wrapper could be



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used to contain used gum as further evidenced by Comino and Badura, both of whom disclose similar wrappings for the containment of used chewing gum.

5. Regarding claim 2, Randak Sr. discloses a method for use with a wrapping to dispose of waste material formed by an upper part and a lower part of identical form and size, the upper and lower parts attached together along their margins as set forth above in the rejection of claim 1.

6. The method comprises depressing two sides of the wrapping with the fingers thereby opening the wrapping (fig. 1) to deposit used waste material (ashes). While not specifically disclosing spitting used chewing gum into the wrapping from the mouth without direct contact with the fingers, it would have been obvious to do so in order for the user to avoid soiling the hands. After depositing the used waste material into the wrapping the user presses (pinches) the upper and lower parts together (col. 1, ln 56 – col. 2, ln 3 and fig. 2). After use the wrapping is discarded (col. 1, ln 7 – 9).

7. Claim 2 differs in the particular material being disposed of, that is, claim 2 recites used chewing gum whereas Randak, Sr. discloses ashes. Randak, Sr. is not considered to be limited to cigarette ashes, but instead is seen to have been a generic teaching applicable to any disposable material. Stated somewhat differently, once it was known to employ a wrapping of essentially the same structure, the particular disposable material one chooses to discard in said wrapping would have been an obvious matter of choice. As further evidenced by Comino and Badura applicant is not the first to use preformed wrappers to dispose of used chewing gum.



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8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comino et al. EP 0 642 993 as further evidenced by Randak, Sr. US 2,990,100.

9. Regarding claim 1, Comino discloses a wrapping for used chewing gum (col. 1, ln 3 – 14) characterized in that the wrapping is formed by an upper part and a lower part of identical form and size, and the upper and lower part are disposed to be applied together by their full surfaces (fig. 1 – 3). Both parts are provided with opposite situated vertical pre-scored lines and the parts are attached together along their margins (fig. 1 and 3). With respect to the margins being attached together from one half to one third the circumference of the parts, the particular amount of circumferential attachment is seen to have been an obvious matter of choice and/or design.

10. Regarding claim 2, Comino discloses a method for use with a wrapping formed by an upper part and a lower part of identical form and size, the upper and lower parts attached together along their margins as set forth above in the rejection of claim 1.

11. Claim 2 differs from Comino in specifically depressing two sides of the wrapping with the fingers to open the wrapping. Comino discloses that the wrapping can be configured as a cone (fig. 1) or a paper boat (figure 3 embodiments 2 and 4) which would obviously be openable by squeezing together the sides of said wrappings as further evidenced by Randak, Sr. who discloses a similar wrapping that is opened by squeezing together the sides of the wrapping. Comino further discloses that once a specific residue, such as chewing gum (col. 1, ln 3 – 14), has been deposited in the wrapper the upper and lower parts of the wrapper are pressed together (duly closed) (col. 3, ln 3 – 8) after which the wrapping is discarded (final disposal) (col. 4, ln 23 – 25)



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12. While not specifically disclosing spitting the used chewing gum into the wrapping from the mouth without direct contact with the fingers, Comino does disclose the wrapper the wrapper's purpose is to provide the user with a way of hygienically disposing of used chewing gum by such a way so as to solve problems with respect to personal hygiene and create positive effects on the public health (col. 2, ln 15 – 31). Such positive effects would obviously require minimal contact with the chewed gum making it obvious that said gum would be spit into said wrapper to avoid contamination of the user's hands and subsequent spreading of germs.

13. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badura EP 0 779 040.

14. Regarding claim 1, Badura discloses a wrapping for used chewing gum (col. 1, ln 3 – 5) characterized in that the wrapping is formed by an upper part and a lower part of identical form and size (col. 2, ln 46 – 50, fig. 1 and 2), and the upper and lower part are disposed to be applied together by their full surfaces. Both parts are provided with opposite situated vertical pre-scored lines and the parts are attached together along their margins partially (col. 3, ln 58 – col. 4, ln 10 and fig. 1 and 3). With respect to the margins being attached together from one half to one third the circumference of the parts, the particular amount of circumferential attachment is seen to have been an obvious matter of choice.

15. Regarding claim 2, Badura discloses a method for use with a wrapping formed by an upper part and a lower part of identical form and size, the upper and lower parts attached together along their margins partially from one third to one half of the



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circumference of the part, the method comprising depressing two sides of the wrapping with the fingers thereby opening the wrapping. While not specifically disclosing spitting used chewing gum into the wrapping from the mouth without direct contact with the fingers, it would have been obvious to do so in order for the user to avoid soiling the hands. Afterwards the upper and lower parts press together (col. 3, ln 5 – 31 and fig. 2). Since the wrapping of Badura is meant to contain materials to be disposed, such as cigarette ashes and used chewing gum it would have been an obvious matter of choice to discard said wrapping when used chewing gum has been deposited within the wrapping.

#### ***Information Disclosure Statement***

16. It is noted that the information disclosure statement references Santos Comino EP 0 642 933. EP 0 642 933 is however by Tanaka et al. and is directed to methods of printing and printed matter.

#### ***Conclusion***

17. The prior art made of record on the PTO 892 form and not relied upon for the rejection is considered pertinent to applicant's disclosure. Kara US 4,905,823, Godwin US 3,347,450, O'Neill US 712,087, Smith US 2003/0150766, Richardson US 820,067, Cook US 2,432,656, and Carlson et al, 2,812,891 all disclose wrappings which can be opened by squeezing and are capable of containing used chewing to be disposed of.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAIM SMITH whose telephone number is (571)270-7369. The examiner can normally be reached on Monday-Thursday 7:30-5:00.



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19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. S./  
Chaim Smith  
Examiner, Art Unit 1794  
07 March 2010

/Steve Weinstein/  
Primary Examiner, Art Unit 1794